


**UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
02/952,014	10/27/97	MORANDO	

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IM41/1119

EXAMINER

YEE, D

ART UNIT

PAPER NUMBER

DATE MAILED:

11/19/98

 This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS
OFFICE ACTION SUMMARY

- ☒ Responsive to communication(s) filed on 10-29-98
- ☐ This action is **FINAL**
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11,453 O.G. 213.

 A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).
Disposition of Claims

- ☒ Claim(s) 1-6 and 16-22 is/are pending in the application.
- Of the above, claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-6 and 16-22 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claims _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) _____
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

- ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☒ Notice of Reference Cited, PTO-892
- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s) _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

- SEE OFFICE ACTION ON THE FOLLOWING PAGES -

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Response to Arguments

1. Applicant's arguments with respect to claims 1 to 6 and 16 to 22 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1 to 6 and 16 to 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Way et al., (US Patent No. 4,034,588).

The reference teaches an alloy with constituents whose wt% ranges overlap those recited by the claims; such overlap renders applicant's composition *prima facie* obvious despite differences in non-overlapping areas, see *In re Malagari*, 182 USPQ549. See Claim 1, col. 6. Although Mn is not disclosed as an alloying constituent, it is still present as shown by the specific examples in the range of 0.06 to 1.07% which is within applicant's Mn range of more than zero but less than 6.0%. To distinguish over prior art, applicant needs to prove that the more narrowly claimed ranges to various constituents

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are somehow critical and productive of new and improved properties. For example Way teaches the broad range of W in a markush group up to 30% with a preferred range of 15-17.88% which is slightly higher than W range of $1.0 < W < 15.0\%$ recited in claim 1. Applicant needs to demonstrate how a composition with slightly less than 15% vs a composition with slightly more (say 15.05%) would depict more than just an increase in the proportion of element without any attendant unexpected results. Also it should be noted that the W range in claim 1 does not appear to be so critical since a broader range of $1 < W < 30\%$ is recited in claim 22 of the present invention.

Although prior art does not teach an article intended to be submerged in molten zinc and low percentage aluminum/zinc melts as recited by the claims, such would not be a patentable difference since it is merely applicant's future and intended use.

Double Patenting

4. Claims 1 to 6 and 16 to 22 of this application conflict with claim 49 of Application No. 08/909,117. 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. Applicant is required to either

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cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822.

Claims are in conflict because they both disclose an article steel with overlapping or encompassing alloy wt% ranges.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Deborah Yee whose telephone number is (703) 308-1102.


DEBORAH YEE
PRIMARY EXAMINER
GROUP 1300

dy

November 17, 1998